

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ESTHER WESSELS and JOHANNES F. HIGLER

MAILED

SEP 22 2004

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2004-1951
Application No. 10/025,684

ON BRIEF

Before KIMLIN, GARRIS and DELMENDO, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-11 and 23-28. Claim 12 stands withdrawn from consideration.

Claim 1 is illustrative:

1. A laser markable polymer composition of light color comprising:

a) a polymer

b) from 0.1 to 10 wt %, relative to the total weight of the polymer composition, of antimony trioxide particles having an average particle size above 0.5 micrometer; and

c) a nacreous pigment.

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The examiner relies upon the following references as evidence of obviousness.

Kehal	6,043,304	Mar. 28, 2000
Gareiss et al. (Gareiss)	6,184,282	Feb. 06, 2001
	(applicable filing date Mar. 04, 1998)	
Andes et al. (Andes)	6,280,520	Aug. 28, 2001
		(filed Apr. 19, 1999)
Fujita (JP '291)	JP 8-41291	Feb. 13, 1996

Appellants' claimed invention is directed to a laser markable polymer composition comprising a polymer, antimony trioxide and a nacreous pigment. According to appellants, "the laser markings formed during use of the composition by exposure of the composition to irradiation with laser light are darker than the color of the polymer composition which has not been exposed to irradiation with laser light" (page 5 of brief of principal brief, penultimate paragraph).

Appealed claims 1-11 and 23-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over JP '291 in view of Andes and Kehal or Gareiss.

Upon careful consideration of the opposing arguments presented on appeal, we find ourselves in agreement with

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appellants that the examiner has failed to establish a prima facie case of obviousness for the claimed subject matter. Accordingly, we will not sustain the examiner's rejection.

JP '291 is specifically directed to a laser markable epoxy resin composition comprising carbon black and antimony trioxide. When the carbon black of the reference disclosure is irradiated with an yttrium aluminum garnet laser, the carbon black burns and evaporates leaving a whitish printing on a black background (see page 7 of the English translation). JP '291 attaches significance to the average particle diameter and quantity of antimony trioxide used in combination with the carbon black. (See page 9 of translation). JP '291 provides no teaching or suggestion of using any other pigment in combination with carbon black and antimony trioxide, let alone the specifically claimed nacreous pigment.

Andes is directed to the preparation of a multilayer plural luster pigment, i.e., a nacreous pigment, and provides the general disclosure that the specially prepared pigments can be used for laser marking of polymeric materials (column 2, lines 43-46).

It is the examiner's position that it would have been obvious for one of ordinary skill in the art to use the nacreous

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pigment of Andes as a filler in the laser marking composition of JP '291.

Since JP '291 is directed to a very specific combination of carbon black and antimony trioxide in an epoxy resin composition, we must agree with appellants that the examiner has not established the requisite reasonable expectation of success for adding a nacreous pigment into the composition of JP '291. The examiner fails to point to any teaching in JP '291 that allows for the incorporation of other pigments into the composition. The examiner explains that "Ande's suggestion to use the pigment/s for laser-making [sic. laser-marking] should surely serve as an appropriate direction to a person of ordinary skill in the art to use the pigment in a laser-making [sic. laser-marking] composition with the possibility that one can obtain better product/s using such pigment/s" (page 4 of answer, last paragraph, emphasis added). Manifestly, the "possibility" of success is not the test for establishing obviousness under 35 U.S.C. § 103. The examiner seems to be applying the verboten obvious-to-try standard.

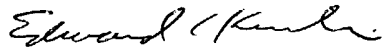
One final point remains. Upon return of this application to the examiner, the examiner should consider the obviousness of

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employing antimony trioxide as a pigment or flame retardant in the nacreous pigment-containing laser marking polymeric material referenced by Andes. JP '291 teaches that antimony trioxide is a conventional flame retardant, and appellants' specification states that the Nd:YAG laser employed in the present invention is the one "most commonly used for applying markings" (page 1, line 33).

In conclusion, based on the foregoing, the examiner's decision rejecting the appealed claims is reversed.

REVERSED


EDWARD C. KIMLIN)
Administrative Patent Judge)


BRADLEY R. GARRIS)
Administrative Patent Judge)


ROMULO H. DELMENDO)
Administrative Patent Judge)

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